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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,100	04/20/2001	Goran Eriksson	45687-00054	1746

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ERICSSON INC.
 6300 LEGACY DRIVE
 M/S EVR C11
 PLANO, TX 75024

EXAMINER

MARTINEZ, DAVID E

ART UNIT PAPER NUMBER

2182

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,100

Applicant(s)

ERIKSSON ET AL.

Examiner

David E Martinez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 6-16, are under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 00/11886 to Telia.

1. With regards to claims 1, 13, Telia teaches a method in a communication network for invoking services [see abstract], the communication network comprising at least one or more terminals and at least two service entities [page 4 lines 14-19], the method being characterized by the following steps:

a) deducing at a terminal necessary support and service components for providing an end-user service [page 4 lines 10-23],

b) constructing at the terminal a set of configuration requests, each associated with one or more specific service entities for invoking individual service components composing a service [page 20 lines 10-13, several requests can be sent over a period of time],

c) forwarding each configuration request from the terminal in a way chosen in accordance with predefined criteria [page 5 lines 9-12, page 20 lines 10-13];

wherein the pre-defined criteria are selected from the group consisting of:

geographical position; price; signaling amounts; available equipment [page 4 lines 10-23]; spectrum allocation; desired performance/characteristics [page 4 line 10 to page 5 line 3].

2. With regards to claim 3, Telia teaches the method of claim 1, characterized in that depending on the predefined criteria, two or more of the configuration requests are forwarded to

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the service entities in a coordinated way by using network support [page 4 lines 10-23, page 5 lines 10-18].

3. With regards to claim 4, the method of claim 1, characterized in that all decisions about the composing of the service and the way of forwarding the requests is made by the terminal [page 7 lines 17-25].

4. With regards to claim 5, the method of claim 1, characterized in that the decisions about the composing of the service and the way of distributing the requests is partly made by using the network support [page 4 lines 10-23, page 5 lines 10-18].

5. With regards to claim 6, Telia teaches a terminal in a communication network for invoking services [page 20 lines 10-13], the communication network comprising at least one or more terminals [page 4 lines 14-19] and at least two service entities [page 4 line 24 to page 5 line 3 and lines 9, 10, 17, 18], the terminal being characterized by

a) means for deducing at a terminal necessary support and service components for providing an end-user service [page 4 lines 10-23],

b) means for constructing a set of configuration requests, each associated with one or more specific service entities for invoking individual service components composing a service [page 20 lines 10-13],

c) means for choosing a way for forwarding each configuration request in accordance with predefined criteria [page 5 lines 9-12, page 20 lines 10-13].

d) means for forwarding each configuration request in the way chosen [page 5 lines 9-12, page 20 lines 10-13].

6. With regards to claim 7, Telia teaches the terminal of claim 6, characterized by means for forwarding two or more of the configuration requests to the service entities in a coordinated way by using network support [page 4 lines 10-23, page 5 lines 10-18].

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7. With regards to claim 14, Telia teaches the communication network of claim 13, characterized in that the means for forwarding each or a part of the configuration requests to the service entity/entities is one or more separate assembler units between the terminal and the service entity [pg 4 line 24 to page 6 line 13, and page 7 lines 10-16].

8. With regards to claim 15 Telia teaches the communication network of claim 13, characterized in that the means for forwarding each or a part of the configuration requests from the terminal to the service entity/entities in question in accordance with pre-defined criteria are positioned in the terminal [page 7 lines 17-25].

9. With regards to claim 16 Telia teaches the communication network of claim 13, characterized in that the service composed by the individual service components is analysed and distributed by means of the assembler unit [page 20 lines 10-28].

Response to Arguments

With regards to amended claims 1, 6, and 13, applicant argues that the amended claims include the limitations of previously objected claim 2 (now cancelled). Furthermore because of such alleged inclusion, the application should be in condition for allowance. However, the previously objected claim 2 called for the inclusion of every one of six different limitations (geographical position, price, signaling amounts, available equipment, spectrum allocation and desired performance/characteristics) to be required, and it did not have alternative language.

The new amended independent Markush claims 1, 6, and 13 submitted by the applicant are of a new broader scope than old claim 2, since the independent claims no longer require the presence of each element in the group, they only require one element. Because the original claim 2 was not incorporated into the independent claims, the International Publication No. WO 00/11886 to Telia still reads on the claims, thus the application stands rejected.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (703) 305-4890. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Starting October, the examiner can be reached at the new telephone number (571) 272-4152 and new fax number (571) 273-4152.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100